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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/829,508 | 04/09/2001 | Jack G. Winterowd | WEYE117204 | 6724 |
| 26389 | 7590 | 01/26/2004 | EXAMINER | |
| CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC | | | SHOSHO, CALLIE E | |
| 1420 FIFTH AVENUE | | | ART UNIT | PAPER NUMBER |
| SUITE 2800 | | | 1714 | |
| SEATTLE, WA 98101-2347 | | | | |

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/829,508 | WINTEROWD, JACK G. | |
| | Examiner | Art Unit | |
| | Callie E. Shosho | 1714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,9-13,15-22,24-28,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,9-13,15-22,24-28,32 and 33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) Interview Summary (PTO-413) Paper No(s) _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicant's amendment filed 12/29/03.

The following rejection is non-final in light of the use of a new reference against the present claims, namely, Winterowd et al. (U.S. 6,608,131), which was found upon updating the searches. Thus, the finality of the office action mailed 8/13/03 has been withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 32-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(a) Newly added claim 32 recites that the "vegetable oil is present in an amount from about 17% to about 50%". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the above phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

Page 4 of the present specification states that the debonding agent is present at a level of about 10% to about 50% while the example present in the present specification discloses paint composition comprising 21% debonding agent and about 17% soybean oil.

As seen in the example set forth in specification as well as the present claims, the debonding agent “comprises” vegetable oil. That is, the debonding agent comprises other ingredients, one of which is vegetable oil. Further, vegetable oil comprises many other types of oils besides soybean oil such as castor oil, linseed oil, corn oil, etc. for which there is no disclosure in the present specification regarding amounts.

Thus, while there is support in the present specification for the recitation that the debonding agent is present in amount of about 10% to about 50% or from about 21% to about 50% and for the recitation that soybean oil is present in an amount of about 17%, there is no support for the recitation that vegetable oil is present in an amount of about 17% to about 50% given that vegetable oil is but one of the components which comprise the debonding agent and given that the recitation of vegetable oil encompasses many other types of oil besides soybean oil.

(b) Newly added claim 33 recites “soybean oil is present in an amount from about 17% to about 50%”. It is the examiner’s position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the above phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

Page 4 of the present specification states that the debonding agent is present at a level of about 10% to about 50% while the example present in the present specification discloses paint composition comprising 17% soybean oil.

As seen in the example set forth in specification as well as the present claims, the debonding agent "comprises" vegetable oil. That is, the debonding agent comprises other ingredients, one of which is vegetable oil such as soybean oil. Therefore, it is the debonding agent which is present in amount of about 10% to about 50%, not the soybean oil which is one of the ingredients which comprises the debonding agent.

Thus, while there is support in the present specification for the recitation that the debonding agent is present in amount of about 10% to about 50% and support for the recitation that soybean oil is present in an amount of about 17%, there is no support for the recitation that soybean oil is present in an amount of about 17% to about 50% given that soybean oil is but one of the ingredients which comprise the debonding agent.

Non-Statutory Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1714

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5, 9-13 and 15-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-3, 9-13, and 15-22 of copending Application No. 09/943,885 in view of Nonweiler et al. (U.S. 5,700,522).

Although the conflicting claims are not identical, they are not patentably distinct for the reasons as set forth in paragraph 8 of the office action mailed 6/27/02, Paper No. 5.

NOTE: In response to applicant's request on pages 6-7 of the amendment filed 12/29/03 that the double patenting rejection of record be withdrawn in favor of the double patenting rejection set forth in copending 09/943,885, it is noted that, as set forth in MPEP 804 (I) B, only if all other rejections are overcome against the present claims such that the "provisional" double patenting rejection is the only rejection remaining in the present application, should the examiner withdraw the "provisional" double patenting rejection and permit the present application to issue as a patent. Such action would convert the "provisional" double patenting rejection in copending 09/943,885 into a double patenting rejection at the time the present application issues as a patent.

Until such time as described above, the double patenting rejection of record remains against the present claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 9-13, 15-22, 24-28, and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Winterowd et al. '131 (U.S. 6,608,131).

Winterowd et al. '131 disclose composition comprising 10-25% binder, i.e. acrylic latex possessing glass transition temperature of 20-40 °C and pH of 7-9, 2-30% vegetable oil such as soybean oil, 1-4% surfactant that comprises long chain acid such as stearic acid, palmitic acid, and myristic acid and morpholine, 0.1-0.8% viscosity enhancing agent such as carboxymethylcellulose, 0.1-1% titanium dioxide, dispersing agent, preservative, and water (col.5, lines 46-51 and 60-66, col.6, lines 5-20 and 42-46, col.6, line 67-col.7, line 9, col.10, lines 66-67, and col.19, lines 12-15).

Although there is no explicit disclosure that the composition exhibits no sediment formation or phase separation when stored at 2 months at 20 °C or any disclosure of the spreadable rate of the paint, given that Winterowd et al. '131 disclose composition comprising

identical types and amounts of ingredients, it is clear that the composition of Winterowd et al. '131 would inherently exhibit no sedimentation formation or phase separation and would inherently possess spreading rate as presently claimed.

While there is no disclosure that the composition of Winterowd et al. '131 is a paint as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. paint, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition and further that the prior art structure which is a composition comprising identical types and amounts of ingredients as the presently claimed paint is capable of performing the recited purpose or intended use.

In light of the above, it is clear that Winterowd et al. '131 anticipate the present claims.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winterowd et al. '131 (U.S. 6,608,131) in view of Winterowd et al. '037 (U.S. 6,489,037).

The disclosure with respect to Winterowd et al. '131 in paragraph 7 above is incorporated here by reference.

The difference between Winterowd et al. '131 and the present claimed invention is the requirement in the claims of fumed silica.

Winterowd et al. '037, which is drawn to coating for OSB boards, disclose the use of fumed silica as viscosifying agent (col.8, lines 56-57).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use fumed silica in the composition of Winterowd et al. '131 in order to produce composition with desired viscosity, and thereby arrive at the claimed invention.

NOTE: As set forth in amended 35 USC 103(c), subject matter which qualifies as prior art under one or more subsections (e), (f), and (g) of section 102 cannot be applied against the claimed invention if the prior art and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This rule change to 103(c) applies to any patent application filed on or after November 29, 1999. See Official Gazette, April 11, 2000. As noted in the Official Gazette, the "mere filing of a

continuation application on or after November 29, 1999 will serve to exclude commonly owned 102(e) prior art that was applied, or could have been applied, in a rejection under 103 in the parent application."

Given that the filing date of the present application is subsequent to November 29, 1999, applicant is advised that a statement indicating that Winterowd et al. (U.S. 6,608,131) was commonly owned at the time the present invention was made will be required to remove the rejection under 35 USC 103. See the Official Gazette Notice of April 11, 2000, 1233 OG 54.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
1/15/04